

32. (New) The method of claim 22, wherein opening the saddlebag includes moving the lid in a substantially vertical translational manner with respect to the body to a partially open position, and then moving the lid in a substantially rotational manner with respect to the body to a fully open position.

### **REMARKS**

By this amendment, claims 1-10, 12, 13, and 15-32 are pending in the application. Claims 1, 10, 12, 13, 15, 17, 22, and 23 have been amended, claims 11 and 14 have been canceled, and claims 24-32 have been added. A clean copy of the claims including amendments is attached hereto. Examination and reconsideration of the application as amended and in view of the following remarks are requested.

### **CLAIM REJECTIONS- 35 USC §112**

The Examiner rejected Claims 22 and 23 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 22 and 23 have been rewritten in independent form. Claim 23 also includes limitation similar to those found in the original base claim. Applicants respectfully submit that claims 22 and 23 are allowable.

### **CLAIM REJECTIONS- 35 USC §102**

The Examiner rejected Claims 17-19 and 21 under 35 USC 102(b) as being anticipated by USPN 5,967,392 to Niemi et al.

Niemi teaches a utility box 20 for a pickup truck cargo bed. The box 20 includes a lid 22 and a storage bin 24 that defines a storage cavity. The bin 24 includes a peripheral lip 30 that is reinforced by a two part aluminum rim 32. The aluminum rim includes engagement slots 34 for two locking hasps 36, 38 of the lid 22. One of the locking hasps includes a key lock 40.

The lid 22 is pivotally joined to the bin 24 by three metal hinge pins 48, 50, 52 that are welded to corresponding positioning brackets 53, 54, 55. The positioning brackets are in turn connected to the lid 22 and the bin 24 by brackets 56, 57, 59. The bracket 56 includes a triangular flange 60 to which is attached an air spring 66. The air spring is interconnected between the triangular flange 60 and a sheet metal lid-mounted support bracket 76. The air spring 66 holds the lid 22 of the cargo bed utility box 20 open, allowing ready access to the bin interior.

Amended Claim 17 relates to a motorcycle saddlebag and calls for, among other things, a body, a lid, a hinge assembly coupling the body to the lid and defining at least two non-collinear pivot axes, a biasing member biasing the lid toward an open position, and a latch resisting the biasing force of the biasing member to hold the lid in a closed position until the latch is disconnected. Niemi does not teach or suggest a hinge assembly defining at least two non-collinear pivot axes. Niemi teaches a utility box including three metal hinge pins 48, 50, 52 that are all substantially coaxially aligned with one another to define a single pivot axis. Neither the drawings nor the specification of Niemi teach, describe, or suggest the structure of amended claim 17. Applicants respectfully submit that amended claim 17 is therefore allowable.

Claim 19 also relates to a motorcycle saddlebag and calls for, among other things, a locking assembly including a latch mounted to said lid, a push button slidably mounted to the body, and a hook pivotally mounted to the push button by a pin, wherein depressing the push button causes the hook to pivot about the pin. Niemi does not teach or suggest a push button slidably mounted to the body, nor does Niemi teach or suggest a hook pivotally mounted to the push button by a pin. Niemi teaches locking hasps 36, 38 mounted to the lid 22. One of the locking hasps 36 has a key lock 40, and the other hasp 38 has a lock 41 slaved to the key lock 40 by a link rod 42. The hasps 36, 38 engage the slots 34 in the aluminum rim. Neither the drawings nor the specification of Niemi teach, describe, or suggest the structure claimed in claim 19. Applicants respectfully submit that claim 19 is therefore allowable.

Claim 21 relates to a method for opening a motorcycle saddlebag and calls for, among other things, moving the lid in a substantially vertical translational manner to a partially open position, and then moving the lid in a substantially rotational manner to a

fully open position. The Examiner contends that the method of claim 21 is inherent in the use of the device of Niemi. Applicants respectfully remind the Examiner that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The Examiner has provided no such facts or technical reasoning in the Office action. Applicants submit that the lid 22 of Niemi is not capable of moving in a translational manner with respect to the bin 24. The lid 22 and the bin 24 of Niemi are coupled to each other by three metal hinge pins 48, 50, 52 that are all substantially coaxially aligned, as such, relative movement between the lid 22 and the bin 24 is purely rotational. Applicants respectfully submit that the subject matter of claim 21 is not taught or suggested by Niemi, and that claim 21 is therefore allowable.

The Examiner rejected Claim 1 under 35 USC 102(e) as being anticipated by USPN 6,338,260 to Cousins et al.

Cousins teaches a lockable accessory device for a motorcycle saddlebag 10. The saddlebag 10 includes a main leather body 11 defining an enclosure 12. A mounting frame 13 is secured within the enclosure 12 and defines a rectangular opening 14. A closure flap 15 extends from the main body 11 in hinged relation thereto. A locking insert 20 has a rigid lid member 21 that defines a lid top 22. The lid top is secured to the mounting frame 13 by an elongated hinge fitting 25 and is pivotable to overlie the rectangular opening 14 of the mounting frame 13.

Amended claim 1 relates to a motorcycle saddlebag and calls for, among other things, a body having an inner surface defining a cavity, a lid having an inner surface and movable between an open position, in which the lid does not cover the cavity, and a closed position, in which the inner surface of the lid defines an upper boundary of the cavity and fully covers the cavity, and a hinge assembly interconnecting the body and the lid and completely enclosed within the cavity when the lid is closed. The hinge assembly includes a first mounting member coupled to the inner surface of the body, and a second mounting member coupled to the inner surface of the lid.

Cousins does not teach or suggest a hinge assembly including a second mounting member mounted to the inner surface of the lid, wherein when the lid is closed, the inner

surface defines an upper boundary of the cavity and the hinge assembly is completely enclosed within the cavity. The hinge fitting 25 of Cousins is mounted to the lid top 22. When the lid top 22 is closed to overlie the rectangular opening 14, the hinge fitting of Cousins is not completely enclosed within the cavity that is defined by the mounting frame 13 and the lid top 22. When the closure flap 15 is closed, the hinge fitting 25 is completely enclosed within the enclosure 12. However, the lid top 22 to which the hinge fitting is secured does not define the upper boundary of the enclosure 12. Neither the drawings nor the specification of Cousins teach, describe or suggest the structure claimed in claim 1. Applicants respectfully submit that claim 1 is therefore allowable.

#### CLAIM REJECTIONS- 35 USC §103

The Examiner rejected Claims 11, 13, 15, and 16 under 35 USC 103(a) as being unpatentable over LaRochelle.

LaRochelle teaches a carrier 19 that defines a storage compartment 24. The carrier has a top opening 25 that can be closed by a cover 26 that is pivotally coupled to the cover by a hinge 27. The carrier 19 includes a groove 31 surrounding the opening and containing a sealing ring 32. An inwardly extending flange 33 of the cover 26 engages the ring 32 to provide a watertight seal between the cover 26 and the carrier 19.

Claim 11 has been canceled, rendering the rejection thereof moot.

Claim 13 has been amended to include the subject matter of originally-filed claim 14, which the Examiner previously held allowable. Applicants submit that amended claim 13 is therefore allowable.

Claims 15 and 16 depend from claim 13 and are allowable as well.

The Examiner rejected claim 1 under 35 USC 103(a) as being unpatentable over LaRochelle in view of Vandergriff.

Vandergriff teaches a sealing hinge assembly. The hinge assembly includes a first leaf 30 and a second leaf 50. A linking member 70 interconnects the first leaf 30 and the second leaf 50. Hinge pins 81 allow pivotal movement between the first leaf 30 and the linking member 70, and between the second leaf 50 and the linking member 70. A

seal 91 carried by the first leaf 30 contacts the second leaf 50 in both the open and closed positions.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1. To establish a *prima facie* case of obviousness there must be a reasonable expectation of successfully combining the references.

Applicants submit that there is no reasonable expectation that a combination of the saddlebag of LaRochelle and the hinge of Vandergriff would be successful. Viewing Fig. 3 of LaRochelle, with the cover 26 in the closed position, the hinge 27 appears relatively flat. Assuming that the Vandergriff hinge were combined with the LaRochelle saddlebag, the hinge configuration illustrated in Fig. 3 of Vandergriff would correspond to the closed position, and the hinge configuration illustrated in Fig. 2 would correspond to the open position. With this in mind, the Vandergriff hinge would be secured to inside surfaces of the cover 26 and the carrier 19 in accordance with the limitations of claim 1. Applicants point out that mounting the hinge in this manner is exactly the opposite of what is shown in Fig. 3 of LaRochelle (e.g. the hinge 27 is illustrated on the outside).

Assuming that the first leaf 30 is coupled to the carrier 19, and the second leaf 50 is coupled to the cover 26, some portion of the cover would have to extend to cover the second contact surface 58 (see Fig. 7) in order to enclose the entire hinge assembly when the cover is closed. Applicants submit that attempts to open the cover with the hinge of Vandergriff installed in the manner described above would be futile. The portion of the cover that hides the second contact surface would collide with the carrier or with the first leaf 30 as the cover is moved toward an open position, making the saddlebag impossible to open without damaging the saddlebag components. In view of the above, Applicants submit that there is no reasonable expectation that a combination of the hinge of Vandergriff and the saddlebag of LaRochelle meeting the limitations of claim 1 would be successful.

Applicants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1, and that claim 1 is allowable.

ALLOWABLE SUBJECT MATTER

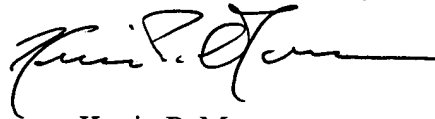
Applicants note with appreciation the indication of allowable subject matter. Claim 12 has been rewritten in independent form and includes limitations similar to those found in the original base claim. Applicants submit that claim 12 is therefore allowable.

CONCLUSION

In view of the foregoing, entry of the above amendment and allowance of the pending claims are respectfully requested.

The undersigned is available for telephone consultation.

Respectfully submitted, ✓



Kevin P. Moran  
Reg. No. 37,193

File No. 043210-1395-00

Michael Best & Friedrich LLP  
100 East Wisconsin Ave.  
Milwaukee, WI 53202  
(414) 271-6560

T:\CLIENTA\043210\1395\F0009349.1